



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,384	01/11/2001	Hau H. Duong	A-68718-2/RFT/RMS/RMK	2482
32940	7590	09/29/2005	EXAMINER	
DORSEY & WHITNEY LLP 555 CALIFORNIA STREET, SUITE 1000 SUITE 1000 SAN FRANCISCO, CA 94104			SINES, BRIAN J	
		ART UNIT		PAPER NUMBER
				1743

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/760,384

Applicant(s)

DUONG ET AL.

Examiner

Brian J. Sines

Art Unit

1743

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) The period for reply expires 6 months from the mailing date of the final rejection.
 b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) They raise the issue of new matter (see NOTE below);
 (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): _____.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.

12. Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.

13. Other: _____.

ADVISORY ACTION

Response to Arguments

Applicant's arguments filed 9/22/2005 have been fully considered, but they are not persuasive. The applicants argue that there is no motivation to combine the references because the scientific principles of operation of the methods described by the references are incompatible. The applicants also argue that the combined references do not provide a reasonable expectation of success of combining the optical detection device of Eggers with the electrical detection-based device of Holen. In response the applicants arguments that there is no suggestion to combine the references, the court has held that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990) (quoting *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986)); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). However, the “suggestion to modify the art to produce the claimed invention need not be expressly stated in one or all the references used to show obviousness.” See *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985). Rather, the test is whether the combined teachings of the prior art, taken as a whole, would have rendered the claimed invention obvious to one of ordinary skill in the art. See *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). The Courts have held that “[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” See *In re Rouffet*, 149 F.3d 1350, 1357, 47

USPQ2d 1453, 1457 & 1458 (Fed. Cir. 1998) (see MPEP § 2143.01). In response to applicant's argument that the detection system of Eggers cannot be essentially bodily incorporated within the Holen system, the test for obviousness is not whether the features of a secondary reference may be *bodily incorporated* into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Holen teaches an automated analytical system for testing biological samples, which incorporates a binding system (e.g., binding layer 83 with an associated capture reagent) and comprises a plurality of test sites (84) for facilitating detection (see col. 13, line 34 – col. 14, line 41). Eggers teaches a multisite electronic detection apparatus comprising a plurality of test sites (14) comprising well (20), which comprises a plurality of electrode pairs (24a & 24b) for the analysis of biological samples (see col. 3, line 54 – col. 4, line 60; figures 1 – 3). Eggers teaches that probes (26) are attached to the bottom of the well for facilitating sample analysis via binding (see col. 4, lines 37 – 66). Both systems and methods rely on an immobilized binding configuration to facilitate sample analysis. Eggers further teaches that their disclosed system can afford increased detection sensitivity, thus providing an incentive or suggestion an ordinary person of ordinary skill in the art would have been reasonably apprised of (see col. 3, lines 11 – 25). The rationale to support an obviousness rejection under 35 U.S.C. 103 may rely on logic and sound scientific principle (see MPEP § 2144.02). The Court has recognized that an artisan is presumed to have skill, rather than lack of skill. See *In re Sovish*, 226 USPQ 771 (Fed. Cir. 1985). Hence, a person of ordinary skill in the art would accordingly have had a reasonable expectation for success of utilizing such an

electronic detection system and methodology as taught by Eggers for analyzing biological samples in a similarly configured format and methodology as taught and suggested by Holen. The Courts have held that the prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) (see MPEP § 2143.02). Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate an electron detection system with the systems and methodology as taught and suggested by Eggers and Holen.

In conclusion, the applicant additionally argues that the incorporation of the teachings of Eggers with the apparatus disclosed by Holen is not compatible since the Holen apparatus also incorporates rotational, tilting and agitation features. However, with respect to claim 24, the features upon which applicant relies (i.e., the rotational, tilting and agitating features) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). (“Many of appellant’s arguments fail from the outset because, as the solicitor has pointed out, they are not based on limitations appearing in the claims.”). See *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, Ph.D. whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jill A. Warden".